

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 13
BAC

10/4/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re V Communications, Inc.

Serial No. 75/347,743

Douglas A. Chaikin of Peninsula IP Group for V
Communications, Inc.

James T. Griffin, Trademark Examining Attorney, Law Office
103 (Michael Szoke, Managing Attorney).

Before Walters, Chapman and Wendel, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On August 27, 1997, V Communications, Inc. filed an application, based on Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), to register the mark OS WIZARD on the Principal Register for "computer software for managing hard drives." Subsequently, applicant filed an amendment to allege use (which was accepted by the Examining Attorney in the first Office action), asserting dates of first use and

first use in commerce of September 2, 1997 and November 17, 1997, respectively.

The Examining Attorney refused registration on two grounds: (1) that the term OS WIZARD when applied to the goods of the applicant, is merely descriptive of the goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1); and (2) that the specimens submitted by applicant do not show use of the term OS WIZARD as a trademark, and thus, the term does not function as a trademark under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127.

When the refusals were made final, applicant appealed to this Board. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

Preliminarily, we will address the additional evidence submitted by applicant, as well as applicant's requests for remand, filed with its brief and reply brief.

Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal; that the Board will not ordinarily consider additional evidence filed by applicant or the Examining Attorney after the appeal is filed; and that after the appeal is filed either the Examining Attorney or applicant may request that the Board suspend the appeal and remand

the application to the Examining Attorney for further examination. A request for remand must include not only the additional evidence, but also a showing of good cause for the remand. See TBMP §1207.02, and cases cited therein.

With its brief on the case applicant submitted additional evidence (consisting of excerpts from the operating manual, packaging material, and an advertising sheet for applicant's System Commander® product) and a request that if the Board would not consider the evidence, the application be remanded to the Examining Attorney. In the Examining Attorney's brief on the case, he noted the untimely evidence, but stated he did not object thereto. In view thereof, the evidence submitted with applicant's brief on the case has been considered in our decision, and applicant's request for remand is moot.

With applicant's reply brief on the case it submitted different additional evidence (copies of several third-party registrations) and again requested that if the Board would not consider this evidence, the application be remanded to the Examining Attorney. Inasmuch as this material was submitted untimely, and applicant has not established good cause for remand pursuant to Trademark Rule 2.142(d), the request for remand is denied, and this

evidence has not been considered in our determination of this case. We add that even if this evidence had been considered, it would not have altered our decision herein.

Turning to the refusal to register on the basis that the term OS WIZARD does not function as a trademark as used by applicant, the Examining Attorney contends as follows (brief, pp. 11-12):

The proposed mark does not function as a trademark because it is merely informational and would not be perceived by the public as a trademark for a software program. The mark as used in applicant's specimens would be perceived by the public merely as a pull down menu which is a component of the overall program. [System Commander Deluxe] Given that the "OS Wizard" menu is in the same font and size as the five other menus beside it, it seems highly unlikely that the public would perceive that particular pull down menu as either a mark or the source of the goods. The term "OS Wizard" used as a pull down menu is no more a trademark for the goods than the menus "Setup" and "Detail" next to it are. It simply tells the user where in the program to click in order to access the operating system installation wizard.

The specimen of record is one side of a box that is the packaging for the goods. We agree with the Examining Attorney that applicant's use of the term "OS WIZARD" on the pull down menu on the computer screen pictured on its specimen of record is use which does not function as a

trademark. However, there are other uses of the term "OS WIZARD," appearing on the same specimen, which are valid trademark uses. For example, the specimen includes the following uses: "OS Wizard™ creates the best configuration for your new operating system" appearing in a box (titled "System Commander Features") in the corner of the specimen; and in the text of the specimen is the heading "OS Wizard™. The easiest way to install your new OS"; and the sentence "System Commander Deluxe introduces the OS Wizard!"

Because there are valid trademark uses of the applied-for mark on the specimens of record, we find that the Examining Attorney's refusal to register OS WIZARD on the basis that it does not function as a trademark cannot be upheld. This refusal is accordingly reversed.

Turning next to the refusal to register on the basis that the term OS WIZARD is merely descriptive¹, the Examining Attorney contends that "OS" refers to "operating system" and "wizard" refers to an interactive help utility in computer software; and that in combination the term OS WIZARD connotes a computer help utility relating to an

¹ Our finding that the applied-for mark is used as a trademark on the specimens is, of course, an issue totally separate from the issue of mere descriptiveness of the mark in relation to the involved goods.

operating system. Essentially, it is the Examining Attorney's position that the term OS WIZARD is merely descriptive of a significant feature, function or purpose of applicant's goods.

In support of his position, the Examining Attorney submitted dictionary definitions of "OS" from, inter alia, Webster's Unabridged Dictionary (Second Edition) where "OS" is defined as "2. Computers. operating system," and Microsoft Press Computer Dictionary (Third Edition) where "OS" is defined as "See operating system." The Examining Attorney also submitted the Webster's New World Dictionary of Computer Terms (Sixth Edition) definition of "wizard" as follows²:

"An interactive help utility, originally developed by Microsoft for its Windows applications (and now widely imitated). The wizard guides the user through each step of a multi-step operation, offering helpful information and explaining options along the way."

² The Examining Attorney's request (brief, p. 6) that the Board take judicial notice of dictionary definitions attached to his brief is granted. See TBMP §712.01, and cases cited therein. However, applicant's request that the Board take judicial notice of three common English dictionaries (which applicant states do not include a definition of "OS") is denied because applicant did not attach copies of the relevant pages from the named dictionaries. In any event, the absence of "OS" from some dictionaries is not persuasive of a different result herein.

In addition, the Examining Attorney relies on applicant's numerous uses of the terms "OS" and "operating system" on its specimens of record. The following are examples: (i) "Now you no longer have to fear losing valuable time and data while working out the kinks with your new operating system (OS)"; (ii) "System Commander® Deluxe makes it safe and easy to get your new operating system up and running..."; (iii) "The safest and easiest way to add a new operating system"; and (iv) "...you can easily add a new OS."

In further support of his position, the Examining Attorney submitted: (i) copies of several excerpted stories from Nexis showing the letters "OS" used in relation to computer goods; (ii) copies of several excerpted stories from Nexis demonstrating descriptive use of the term "wizard" to refer to a computer help utility; (iii) copies of several excerpted stories from Nexis demonstrating use of the term "wizard" in close proximity to the terms "operating system"; and (iv) copies of several third-party registrations, all for computer software, which include disclaimers of either the letters "OS" or the term "wizard."

Examples from the Examining Attorney's Nexis evidence³ showing use of the term "wizard" are shown below:

...And it doesn't take a degree in computer science to set up: A **wizard** guides you every step of the way. ... "P/C Computing," March 1999;

For many users, SmartSuite's new Internet/intranet Web-site development tool will be the jewel in the Millennium Edition's crown. Aptly name FastSite, this slick, easy-to-use tool comes with a **wizard** that should allow even the most computer-phobic to create a no-frills Web site in under 10 minutes flat. ... "Computer Shopper," December 1, 1998;

...The setup **wizard** detects which Windows operating system is running and installs the appropriate drivers. ... "Computer Reseller News," December 21, 1998;

...One beta tester of the Windows 200 operating system was enthusiastic about the Active Directory **wizard**. ... "PC Week," December 21, 1999;

...Network setup is substantially easier with the new version of the operating system. There is a networking **wizard** that sets up all aspects of a network connection,... "InformationWeek," November 2, 1998; and

...Windows 98 is a more stable and robust operating system with additional tools and **wizards** that will help you prevent and/or recover from many problems that plague

³ Applicant argues, citing *In re The American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), that the Examining Attorney's Nexis evidence is "faulty" because it includes no uses of the terms "OS WIZARD" together, and does not show that the public understands the term "OS WIZARD" to refer to a genus of goods. This argument is inapposite as the cited case involves evidence supporting a finding of genericness, not mere descriptiveness.

Windows 95. ... "St. Petersburg Times,"
October 26, 1998.

We note the following use of the word "wizard" by
applicant from page 19 of applicant's user manual
(submitted as an exhibit to applicant's brief on the case):

OS Wizard, by default, always launches
with the wizard dialog box open at the
first screen. To access any of the
menu functions, you will need to first
cancel the wizard. If you go back to
the wizard, simply choose File then OS
Wizard.

Applicant urges reversal on the basis that the burden
of establishing the mere descriptiveness of a mark is on
the Patent and Trademark Office; that the Examining
Attorney improperly dissected the mark rather than
considering the mark as a whole in determining
descriptiveness; that the Examining Attorney's reliance on
specialized computer dictionaries primarily used by
computer professionals is improper because the Office
should be constrained to refer only to common English
dictionaries to show the ordinary significance of the
meaning of words to the public⁴; that under common

⁴ In support of this argument, applicant cites *In re WSI Corporation*, 1 USPQ2d 1570 (TTAB 1986), specifically for the proposition that the Office does not accept the Acronyms, Initialisms, & Abbreviations Dictionary (AIAD) as prima facie evidence of the meanings of such terms. The WSI case is limited to the facts therein, and we do not find it applicable here. (In the case now before us, the Examining Attorney had cited the AIAD for its definition of "OS" as "Operating System [Computer

dictionary meanings "OS" can mean many things (e.g., "old series," "on-site," "operational sequence") and a "wizard" in an ordinary English sense is a sorcerer, magician, or skillful or clever person; that therefore, the terms "OS WIZARD," taken together, could mean "the operational sequence of a magician or sorcerer, or a Wizard who is an operations specialist" (brief, p. 9), or could even refer to a spin on "the famed Frank L. Baum book, *The Wizard of Oz*" (brief, p. 11)⁵; that the purchasing public will have to use imagination and thought to ascertain the nature of applicant's product; that doubt is resolved in applicant's favor; and that competitors could easily compete "by using a slightly different name" and passing this application on to publication "will not inhibit competition" (brief, p. 17).

A term is merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it immediately

science].") Moreover, the Office accepts specialized dictionaries to define words used in particular trades or industries, e.g., medical dictionaries, engineering dictionaries, computer dictionaries. See e.g., *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), aff'd (not for publication), 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989); and *In re Crown Zellerbach Corp.*, 229 USPQ 318 (TTAB 1985).

⁵ While it may be a vague play on the words, we do not agree that the purchasing public would relate OS WIZARD, in the context of applicant's involved goods, to the book "The Wizard of Oz." This is especially true in light of applicant's actual uses of OS WIZARD, none of which refer or relate in any way to the context of the book, "The Wizard of Oz."

conveys information concerning an ingredient, quality, characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term or phrase describe all of the properties or functions of the goods or services in order for it to be considered merely descriptive thereof; rather, it is sufficient if the term or phrase describes a significant attribute of the goods or services.

The issue of whether a particular term or phrase is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used on or in connection with those goods or services, and the possible significance that the term or phrase is likely to have to the average purchaser of the goods or services because of the manner in which it is used. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). See also, 2 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §§11:66-11:71 (4th ed. 2000). Further, the question is not whether someone

presented with only the mark could guess what the goods are. Rather, the question is whether someone who knows what the goods are will understand the mark to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

In this case, the Examining Attorney has met the burden of establishing a prima facie case of mere descriptiveness. In fact, this record includes ample evidence that in the context of applicant's goods, "computer software for managing hard drives," the term "OS" refers to "operating system" (see e.g., dictionaries and applicant's own use of "OS" on its specimens), and the term "wizard" refers to a computer software tool or utility which guides the user through a step-by-step process⁶ (see e.g., the dictionary, Nexis excerpts, and page 19 of applicant's user manual). The term OS WIZARD, considered as a whole and in its entirety, when applied to applicant's computer software products, is merely descriptive of a significant feature, purpose and function of the goods,

⁶ Applicant characterizes its goods as follows (applicant's response filed November 6, 1998, p. 10): computer software that "takes the consumer/user through a process which would help the consumer/user install a new operating system, or offering helpful information and explaining options along the way (by an easy step-by-step guiding process)."

specifically, that the purchasing public would understand, without imagination or conjecture, that applicant's software is an interactive tool or utility used in relation to a computer operating system. That is, we find that the term OS WIZARD, when used in connection with the involved goods, immediately conveys to the purchasing public, the idea of computer software which is an interactive guide tool or utility in relation to a computer operating system. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE merely descriptive for potpourri); *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) [FIRSTIER (stylized) merely descriptive for banking services]; *In re Cryomedical Sciences Inc.*, 32 USPQ2d 1377 (TTAB 1994) (SMARTPROBE merely descriptive of disposable cryosurgical probes); and *In re Medical Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992) (requirement for a disclaimer of the merely descriptive terms "medical disposables" for various disposable wash cloths, garments, bed sheet liners, and the like affirmed).

Further, even if applicant is the first (and/or only) entity to use the term OS WIZARD in relation to computer software for managing hard drives, such is not dispositive where, as here, the term unquestionably projects a merely

descriptive connotation. See *In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953 (TTAB 1994), and cases cited therein.

Suffice it to say that none of applicant's other arguments, nor any of the other cases cited by applicant, is persuasive of a different result on the issue of mere descriptiveness.

Decision: The refusal to register under Sections 1, 2 and 45 is reversed, and the refusal to register under Section 2(e)(1) is affirmed.

C. E. Walters

B. A. Chapman

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board